

REMARKS

Claims 1 to 36 are pending in the application, with Claims 37 to 68 having been canceled and with Claim 22 having been amended herein. Reconsideration and further examination are respectfully requested.

Initially, Applicants affirm the election of Claims 1 to 36 for prosecution in response to the restriction requirement. Accordingly, Claims 37 to 68 have been canceled herein.

Claims 1 to 3, 8 and 10 to 36 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over Claims 1 to 37 and 44 to 48 of co-pending U.S. Application No. 09/923,417 (Nagashima). Applicants respectfully traverse the foregoing provisional double patenting rejection.

"In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is — does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an "obviousness-type" nonstatutory double patenting rejection may be appropriate."

M.P.E.P. § 804 II.B.1. In general, "any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination." M.P.E.P. § 804 II.B.1.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. § 2143.

In the case at hand, Applicants submit that U.S. Application No. 09/923,417 (Nagashima) does not present a *prima facie* case of obviousness with respect to Claims 1 to 3, 8 and 10 to 36 of the subject application. In this regard, Claims 1 to 37 and 44 to 48 of Nagashima are not seen anywhere to disclose or suggest all the claim limitations of independent Claim 1. Particularly, none of the claims of Nagashima are seen to disclose or be concerned with the use of C.I. Acid Red 52, much less where the content of the C.I. Acid Red 52 ranges from 0.1 to 0.4% by weight based on the total amount of the ink, and the weight ratio of the direct dye to the C.I. Acid Red 52 is not higher than 1.6.

Applicants submit that a *prima facie* case of obviousness is not seen to be established by Nagashima with respect to the claims of the subject application. Accordingly, reconsideration and withdrawal of the provisional double patenting rejection is respectfully requested.

Claim 22 was rejected under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness. Applicants submit that the amendment to Claim 22 set forth herein renders moot the foregoing rejection because Claim 22 now clarifies that the amount of nonionic surfactant does not cause separation at an interface portion of the ink where the liquid medium contains no coloring material. Applicants therefore respectfully request reconsideration and withdrawal of the § 112, second paragraph, rejection of Claim 22.

Claims 1 and 6 to 8 were rejected under § 102(e) over U.S. Patent No. 6,176,908 (Bauer); Claims 9 to 12, 32, 35 and 36 were rejected under § 103(a) over Bauer; Claims 10 to 16, 18 to 21, 23 to 26, 28 to 30, 33 and 34 were rejected under § 103(a) over Bauer in view of U.S. Patent No. 5,865,883 (Teraoka); and Claims 2 to 5 were rejected under § 103(a) over Bauer in

view of U.S. Patent No. 5,728,201 (Saito). Reconsideration and withdrawal of these rejections are respectfully requested.

Turning to specific claim language, independent Claim 1 is directed to a fluorescent ink which contains at least a coloring material and an aqueous liquid medium for dissolving the coloring material, wherein the coloring material comprises C.I. Acid Red 52 and at least one direct dye, the content of the C.I. Acid Red 52 ranging from 0.1 to 0.4% by weight based on the total amount of the ink, the content of the direct dye ranging from 0.11 to 0.4% by weight based on the total amount of the ink, and the weight ratio of the direct dye to the C.I. Acid Red 52 being not higher than 1.6.

The applied art, namely Bauer, Teraoka and Saito, is not seen to disclose or suggest the foregoing combination of features of independent Claim 1, particularly with respect to at least the features of coloring material that includes C.I. Acid Red 52 and at least one direct dye, the content of the C.I. Acid Red 52 ranging from 0.1 to 0.4% by weight based on the total amount of the ink, the content of the direct dye ranging from 0.11 to 0.4% by weight based on the total amount of the ink, and the weight ratio of the direct dye to the C.I. Acid Red 52 being not higher than 1.6.

In this regard, Bauer is seen to be directed to aqueous ink jets for postal metering which include a red or magenta pigment, a polymeric dispersant, a fluorescent dye, and, optionally a hydrotope additive. (Bauer, abstract; column 2, lines 1 to 6; and column 3, lines 8 to 22). However, the ink of Bauer is not seen to use the range of content of colorants as in the subject application. Specifically, the content of Acid Red (AR) 52 in any of the examples in Bauer that use Direct Yellow (DR) is not seen to fall under the range of the present invention. The constitution of such examples corresponds to comparative examples I-7 and I-16 of the

subject application, and so there is an obvious difference in the effect. In addition, most of the dyes as used in the Examples of Bauer are Acid Yellow (AY), which are not even direct dyes, and the range of the content of the dyes, except the fluorescent dyes, in Bauer is considerably wide compared to the range specified in the present invention.

Teraoka is not seen to remedy the foregoing deficiencies of Bauer with respect to the present invention. In particular, Teraoka is seen to be directed to an ink which includes triethanolamine in an amount of 2% by weight or more, but less than 5% by weight based on the total weight of the ink, and a dye having a pyrene ring. (Teraoka, abstract; column 2, lines 10 to 35). However, Teraoka is not seen anywhere to be concerned with mixing of dyes, and therefore is not possibly seen to disclose or suggest a coloring material that includes C.I. Acid Red 52 and at least one direct dye, the content of the C.I. Acid Red 52 ranging from 0.1 to 0.4% by weight based on the total amount of the ink, the content of the direct dye ranging from 0.11 to 0.4% by weight based on the total amount of the ink, and the weight ratio of the direct dye to the C.I. Acid Red 52 being not higher than 1.6.

Neither is Saito seen to remedy the foregoing deficiencies of the other applied references. In particular, Saito is seen to be directed to a yellow ink including at least two yellow dyes. (Teraoka, abstract; and column 2, lines 15 to 22). However, Saito is not seen anywhere to be concerned with the use of Acid Red (AR) 52, much less where the content of the C.I. Acid Red 52 ranges from 0.1 to 0.4% by weight based on the total amount of the ink, the content of the direct dye ranges from 0.11 to 0.4% by weight based on the total amount of the ink, and the weight ratio of the direct dye to the C.I. Acid Red 52 is not higher than 1.6.

Accordingly, independent Claim 1 is believed to be in condition for allowance and such action is respectfully requested.

The other pending claims remaining under consideration in this application are each dependent from the independent claims discussed above and are therefore believed patentable for the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of each on its own merits is respectfully requested.

Based on the foregoing amendments and remarks, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

  
Attorney for Applicants

Registration No. 40,595

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-2200  
Facsimile: (212) 218-2200

CA\_MAIN 72878 v1